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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,383	10/10/2000	Gertrud Hoetten	2923-120	7142
6449	7590	03/14/2005	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			MERTZ, PREMA MARIA	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/684,383

**Applicant(s)**

HOTTEN ET AL.

**Examiner**

Prema M Mertz

**Art Unit**

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-28 and 30-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-28, 30, 31, 33, 36-41 and 44 is/are allowed.
- 6) ☐ Claim(s) 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 32, 34, 35, 42, 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

### **DETAILED ACTION**

1. Claims 1-23, and 29 have been canceled. Amended claims 24-27, 31, 35-40, (1/18/2005) and previously presented claims 28, 30, 32-34, 41-43, and new claim 44 (1/18/2005) are pending in the instant application.

2. Receipt of applicant's arguments and amendments filed on 1/18/2005 is acknowledged.

3. The following previous rejections and objections are withdrawn in light of applicants amendments filed on 1/18/2005:

(i) the rejection of claims 25 and 29 under 35 U.S.C. 101, statutory double patenting as claiming the same invention as that of claim 9 of prior U.S. Patent No. 6,120,760;

(ii) the rejection of claims 24-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-12 of U.S. Patent No. 6,120,760.

4. Applicant's arguments filed on 1/18/2005 have been fully considered and were persuasive. The new issues are stated below.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim rejections-35 USC § 112, first paragraph***

6. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Claim 25, line 3 recites "238-240" which language is new matter in the claim, since the instant specification fails to disclose such a limitation. The specification fails to provide proper support for this language in the claims for the following reason:

In the specification page 4, last line to page 5, lines 1-2, discloses:

The start of the mature protein is preferably in the region of amino acids 217-240, particularly preferably at amino acid 236 or 237 and most preferably at amino acid 237.

The specification does not disclose the specific limitations of the mature protein starting at amino acid "238" as recited in the claim 25. This rejection can only be obviated by reciting the specific start sites for the mature protein for which there is support in the instant specification.

***Claim rejections-statutory double patenting***

7. Claim 24 (c) is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 9 and of prior U.S. Patent No. 6,120,760. This is a double patenting rejection.

This rejection is maintained for reasons of record set forth at page 3 of the previous Office action (10/15/2004).

The 352 amino acids of SEQ ID NO:4 in the U.S. patent are 100% identical to the amino acid sequence of SEQ ID NO:2, which amino acid sequence is encoded by the nucleotide sequence of SEQ ID NO:3 in the instant application.

***Conclusion***

Claims 26-28, 30, 31, 33, 36-41, 44 are allowable.

Claims 32, 34, 35, 42, 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

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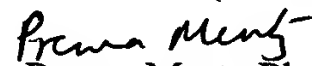
***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (571) 272-0829.

Official papers filed by fax should be directed to (571) 273-8300. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Information regarding the status of an application may be obtained from the Patent application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Prema Mertz Ph.D.  
Primary Examiner  
Art Unit 1646  
March 1, 2005